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Supreme Court of the United States

OCTOBER TERM 1945

No. 500

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ALBA TRADING CO. INC.,

Petitioner

(Defendant below),

against

MUSHER FOUNDATION, INC.,

Respondent

(Plaintiff below).

**PETITION OF ALBA TRADING CO. INC. AND
BRIEF IN SUPPORT OF PETITION
FOR A WRIT OF CERTIORARI**

JOSEPH JOFFE,
Counsel for Petitioner,
141 Broadway,
New York 6, N. Y.

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Supreme Court of the United States

OCTOBER TERM 1945

No.

ALBA TRADING CO. INC.,

Petitioner
(Defendant below),

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against

MUSHER FOUNDATION, INC.,

Respondent
(Plaintiff below).

Petition of Alba Trading Co. Inc.

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATED JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The petition of ALBA TRADING CO. INC., a corporation, respectfully shows to this Court as follows:

I. That this is a petition to review a final decision and judgment in a patent suit, of the United States Circuit Court of Appeals for the Second Circuit, entered July 18, 1945, which judgment reversed a judgment of the District Court of the United States for the Southern District of New York in favor of the defendant and petitioner herein. The District Court decided that United States Patent No. 2,221,404 relating to a substitute for olive oil, and having two claims—one for method and the other for product—was not infringed as to method, and

that the product claim was invalid because of indefiniteness, and dismissed the suit. The Circuit Court held the product claim valid and found that defendant infringed the method claim. The opinion of the Circuit Court of Appeals is found at pages 170 to 176 of the Record. The opinion of the District Court is found at pages 159 to 162 of the Record.

II. This Court has jurisdiction to review the judgment under § 347 of the United States Code (Sec. 240 of Judicial Code) and § 350 of the United States Code.

III. The question presented is the validity of United States Patent No. 2,221,404 granted to respondent on November 12, 1940, upon the application of Sidney Musher, for a process of making a food product of general use, to wit: an imitation olive oil, by infusing a "glyceride" oil—such as cottonseed oil or corn oil—with a "macerated" paste of specially prepared olives (Record p. 170, fol. 171). The process of infusion has been used for generations, as, for instance, in the brewing of tea or coffee, and if the respondent's patent is sustained the respondent will take away from the public domain the right to infuse corn oil or similar oils with any olives, and prevent the general public from enjoying any imitation olive oils, no matter how infused, without a license from the respondent.

IV. A reading of the opinion of the Circuit Court of Appeals makes it apparent that the Court committed error in assuming that the process carried out by the petitioner was equivalent to that of the respondent.

The Court also departed from numerous decisions of this Court and other circuit courts of appeal, in declaring that an inventor who voluntarily abandons certain claims before the issuance of a patent, does not thereby dedicate them to the public. (In the case at bar claims

providing for the elimination of heat as an element were abandoned.) (Record pp. 166 and 173, fol. 174.) Such a ruling is in direct contradiction to the law laid down in:

Schreiber & Co. v. Cleveland Trust Co., 311 U. S. 211, 220 (1940);

Altoona Public Theatres, Inc. v. American Tri-Ergon Corporation, 294 U. S. 477, 492 (1935);

Leggett v. Avery, 100 U. S. 256, 259 (1875).

This decision of the Circuit Court of Appeals is contrary to the law laid down by the Circuit Court of Appeals for the Fifth Circuit in

Dry Hand Mop Co. v. Squeez-Ezy Mop Co. Inc.,
17 Fed. (2d) 465, 466 (1927)

where the Court said:

"The voluntary relinquishment of an element gives the public the right to use it in substitution of any claim of equivalency."

To sustain the process claim it was necessary for the Circuit Court to take the position that "room temperature" and "more time" are equivalents of "a short time" and a "slightly elevated temperature", without any proof or explanation thereof (Record p.173, fol. 174).

The Circuit Court of Appeals overruled the District Court's finding that the product claim does not comply with the statutory requirements of Revised Statutes Sec. 4888 (35 U. S. C. Par. 33). A reading of the product claim of the patent in question demonstrates without argument that the claim is invalid on its face, if the decisions of this Court in

General Electric Co. v. Wabash Appliance Corp.,
304 U. S. 364, 368 (1937);

and

United Carbon Co. v. Binney & Smith Company,
317 U. S. 228, 232 (1942),

are to be followed.

The Circuit Court of Appeals in sustaining the product claim failed to consider that the product of the petitioner is different from that of the patentee (Record, p. 157, Deft's. Exhibit D). Finally we submit that the Circuit Court has entirely overlooked the fact that the patent in question was granted for an infusion process of specially prepared olives as described in said patent (Record, p. 147), whereas the petitioner uses a common variety of olives readily purchased in the open market, known long before the disclosure made by the inventor (Record, p. 120, fol. 358).

V. The reasons relied on for the allowance of the writ are:

(a) The claim for product is invalid on its face under the decisions of this Court in

General Electric Co. v. Wabash Co., 304 U. S.
364, 368 (1937);

United Carbon Co. v. Binney & Smith Co., 317
U. S. 228 (1942).

(b) The Circuit Court of Appeals enlarged the scope of the patent as defined by the process claim, by resort to the doctrine of equivalents, while Musher, the patentee, by withdrawing his other claims in the Patent Office (See Record pp. 166 and 173, fol. 174) has surrendered said claims so far as they would otherwise read upon the alleged infringement, to wit, elimination of heat. (See Opinion, Record, p. 173, fol. 174).

Exhibit Supply Co. v. Ace Patents Corp., 315
U. S. 126 (1942).

(c) The Circuit Court of Appeals misinterpreted the decision of this Court in *General Electric Co. v. Wabash Appliance Co.*, 304 U. S. 364 (1937), and failed to follow the decision of this Court in *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211 (1940).

(d) The decision and judgment of the Circuit Court of Appeals is contrary to the adjudications of this Court in

General Electric Co. v. Wabash Co., 304 U. S. 364, 371-372 (1937);

United Carbon Co. v. Binney & Smith Co., 317 U. S. 228 (1942);

Exhibit Supply Co. v. Ace Patent Corp., 315 U. S. 126 (1942);

Schreiber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211 (1940);

Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 256-258.

(e) The importance of the questions adjudicated by the Circuit Court of Appeals to the administration of the patent laws,

United Carbon Co. et al v. Binney & Smith Co., 317 U. S. 228, 229, 1942);

Sola Electric Co. v. Jefferson Co., 317 U. S. 173, 175.

and the restriction the decision will impose upon the distribution of food to which the public is entitled without reservation.

VI. We most earnestly urge that the statement of law in the opinion of the Circuit Court of Appeals in this case should be corrected lest there be established thereby a precedent which would change the long recognized rules of law as to disclosures under Section 4888 of the Revised

Statutes of the United States (35 U. S. C. § 33), and also that the unprecedented qualification as to the law of disclaimers as affecting patents, be declared erroneous and one not intended by the statute.

Both of these matters are of great importance to the administration of the patent laws, and the Circuit Court rulings are contrary to the public interest. The judgment of the Circuit Court of Appeals in the case at bar deprives the public of the right to enjoy foods known and used long before the granting of the patent.

WHEREFORE, your petitioner prays:

(a) That a writ of certiorari issue out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Second Circuit commanding the said Court to certify and send to this Court on a day to be designated in said writ, a full and certified transcript of the record and of proceedings in the Circuit Court of Appeals for the Second Circuit in a suit entitled "Musher Foundation, Inc., Plaintiff-Appellant, against Alba Trading Co. Inc., Defendant-Appellee, Civil No. 15-395," to the end that the said suit may be reviewed and determined by this Court, as provided in United States Code Title 28, Judicial Code and Judiciary, Section 347, and that the decision and judgment of the Circuit Court of Appeals for the Second Circuit in the said suit may be reversed by this Honorable Court.

(b) That your petitioner may have such other and further relief as to this Court may seem proper and just and in conformity with the laws of the United States.

(c) And your petitioner will ever pray, etc.

ALBA TRADING CO. INC.
By Julius Mario Russo,
General Manager.

JOSEPH JOFFE,
of Counsel for Petitioner.

STATE OF NEW YORK
COUNTY OF NEW YORK } ss.:

JULIUS MARIO RUSSO being duly sworn, deposes and says that he is the General Manager of ALBA TRADING Co. INC. herein; that he has read the foregoing petition and knows the contents thereof, and that the same is true to his own knowledge, except as to the matters herein stated to be alleged upon information and belief, and as to those matters he believes it to be true.

Deponent further says that the reason this verification is made by deponent and not by ALBA TRADING Co. INC. is because the said ALBA TRADING Co. INC. is a corporation, and deponent an officer thereof, to wit, its General Manager.

JULIUS MARIO RUSSO.

Sworn to before me this
9th day of October, 1945.

ORRIE L. SHURE,
Notary Public,
Kings County,
Cert. filed N. Y. County.
Commission expires March 30, 1945.
(NOTARIAL SEAL)

I hereby certify that I have examined the foregoing petition, that in my opinion it is well founded and entitled to the favorable consideration of the Court, and that it is not filed for the purpose of delay.

JOSEPH JOFFE,
Counsel for Petitioner.

Supreme Court of the United States

OCTOBER TERM 1945

No.

ALBA TRADING CO. INC.,

Petitioner
(Defendant below).

against

MUSHER FOUNDATION, INC.,

Respondent
(Plaintiff below).

**BRIEF IN SUPPORT OF PETITION FOR WRIT
OF CERTIORARI**

Argument

The Circuit Court of Appeals sustained Patent No. 2,221,404 granted to respondent on November 12, 1940. The patent has only two claims, one for process, the other for product.

The process claim reads:

"1. The method of treating a glyceride oil to give it novel flavor and odor characteristics which comprises infusing said oil at a slightly elevated temperature with a small amount of a low moisture

containing, dehydrated, macerated olive paste for a short period and then removing the olive paste solids therefrom." (Record, p. 148.)

The product claim reads:

"2. A substantially stabilized glyceride oil having novel flavor and odor characteristics containing a small amount of the glyceride oil soluble constituents derived from a dehydrated, low moisture containing, macerated olive paste, the oil being substantially free of the fibers of said olive paste." (Record, p. 148).

The District Court dismissed the process claim as not infringed (Record p. 160) because petitioner does not use heat (Record p. 159). (Opinion of Circuit Court of Appeals, Record p. 172, fol. 173).

The District Court dismissed the product claim because it did not comply with Section 4888 of Revised Statutes (35 U. S. C. § 33) (Record p. 161).

POINT I

Process claim.

To sustain a charge of infringement of Claim One, the Circuit Court asserts that time and temperature are correlative factors (Record p. 173, fol. 173). The Circuit Court states that "a slightly elevated temperature" and a "short period" are equivalent to "a reduced temperature" and "longer time" (Record p. 173, fol. 174). Temperature and time being correlative factors (Record p. 172, fol. 173), how then can there be equivalency where the factors involved are each indefinite as to their value? To determine the value of the factors "slightly elevated temperature" and "a short period" used in the claim it is necessary to refer to the body of the specification of the patent (Record p. 148, line 6, column 2) where it is

defined as 175° F. and 15 minutes respectively. The value of the factors "reduced temperature" and "longer time" are given in the record (Record p. 173, fol. 173) as room temperature and three days the equivalent of which are 68° F. and 72 hours or 4320 minutes.

Can it be said from the above that the respondent's pair of factors or their product (175 x 15) is equivalent to the petitioner's pair of factors or their product (68 x 72 x 60) respectively? To determine the amount of heat required to process either the respondent's or the petitioner's product many additional factors are needed and are not to be found either in the patent or in the proof submitted. To attempt it is to speculate.

Further, this assertion of equivalency by the Circuit Court presupposes the heating of identical masses as to composition and quantity. But the Circuit Court acknowledges (Record p. 174, fol. 176) that the masses are not identical in composition, for the petitioner uses in the food oil an unsalted olive mass, whereas the patentee uses in the food oil a salted olive mass. It is evident that the quantities of heat in such cases are not identical, particularly where the quantities so heated must of necessity be large in order to manufacture the product.

The Circuit Court of Appeals in discussing the process claim said:

"When this process (petitioner's) is compared with that described in Claim One, two differences, and only two, appear: the process is carried on at room temperature and not for a short time." (Record p. 172, fol. 173).

In this the Circuit Court overlooks another important difference, for the petitioner "does not salt the olives out of which it makes its paste," as the Circuit Court itself points out in its opinion (Record p. 174, fol. 176), while the respondent uses salted paste.

The Circuit Court states in its opinion that the Claim should be read with reference to the specification, but disregards that rule entirely by failing to read into Claim One that the olive paste mentioned therein, as described in the specification, must be salted. (Record p. 147, line 60, column 1, page 147, and lines following in column 2; also lines 23 to 30, column 2 of same page; also lines 43 to 45 in same column).

The patentee states in his patent that unsalted olives are incapable of treatment in accordance with his invention (Record p. 148, lines 21 to 30, column 2). That in itself would negative the statement of the Circuit Court that the petitioner's process is equivalent to the process described in the patent. But this assertion of equivalency still leaves the terms of the Claim One in the use of the terms "at a slightly elevated temperature" and "for a short period" too indefinite to make it good under decisions of this Court.

United Carbon Co. v. Binney & Smith Co., 317 U. S. 228 (1942);

General Electric Co. v. Wabash Corp., 304 U. S. 364 (1937).

In *United Carbon Co. v. Binney & Smith Co.*, *supra*, the Court said, at page 232:

"Section 4888 of the Revised Statutes, 35 U. S. C. Sec. 33, requires that the applicant for a patent 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' As the Court recently stated in *General Electric Co. v. Wabash Corp.*, 304 U. S. 364, 369:

" 'Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protec-

tion of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claims 'measure the invention' * * * In a limited field the variant must be clearly defined.' "

and at page 234:

"Respondent urges that the claims must be read in the light of the patent specification, and that as so read they are sufficiently definite. Assuming the propriety of this method of construction, cf. *General Electric Co. v. Wabash Corp.*, *supra*, at 373-375, it does not have the effect claimed, for the description in the specification is itself almost entirely in terms of function."

and concluded at page 236:

"The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field. Moreover, the claims must be reasonably clear-cut to enable courts to determine whether novelty and invention are genuine."

How can one find from the reading of Claim One, what *temperature* is meant by "a slightly elevated temperature" and what is "for a short period" (as to time)? Both are indefinite.

The respondent in this case is confronted with another objection to the decision of the Circuit Court, for prior to the granting of the patent the respondent voluntarily cancelled therefrom three claims which did not contain the element of heat in the process (Record p. 166, Opinion of CC of A. (Record p. 173, fol. 174). Because of that the petitioner maintained that the respondent was estopped to claim any equivalents (Record p. 173, fol. 174).

The Circuit Court met this argument by holding that only when an examiner rejects a claim and the inventor then withdraws it, does the disclosure *pro tanto* pass into the public domain, thereby estopping the inventor from resorting to the doctrine of equivalents. But when the withdrawal is made by the inventor voluntarily, the rule is otherwise, the Court said. (Record p. 174, fol. 175). This is a departure from well-settled principles as decided more than once by this Court.

Schreiber Co. v. Cleveland Trust Co., 311 U. S. 211, 220 (1940);

Leggett v. Avery, 101 U. S. 256, 259 (1879).

In the case of *Schreiber Co. v. Cleveland Trust Co.*, above cited, Mr. Justice Stone said at page 220:

"It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. *Shepard v. Carri-gan*, 116 U. S. 593; *Sutter v. Robinson*, 119 U. S. 530; *Roemer v. Peddie*, 132 U. S. 313; *Phoenix Caster Co. v. Spiegel*, 133 U. S. 360; *Hubbell v. United States*, 179 U. S. 77; *Weber Electric Co. v. E. H. Freeman Electric Co.*, 256 U. S. 668; *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 443. The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had

without the amendments, the cancellation of which amounts to a disclaimer. *Smith v. Magic City Club*, 282 U. S. 784, 790; *Weber Electric Co. v. E. H. Freeman Electric Co.*, *supra*, 677, 678; *I. T. S. Rubber Co. v. Essex Rubber Co.*, *supra*, 444. The injurious consequences to the public and to the inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. See *Leggett v. Avery*, 101 U. S. 256, 259."

As this Court said in the above case, "the cancellation of a claim amounts to a disclaimer."

A disclaimer has the same consequences whether made voluntarily or by compulsion.

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477 (1935).

In the above case this Court, speaking through Mr. Justice Stone, stated, at page 492:

"* * * The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public."

Walker on Patents (Deller's Edition), vol. 1, p. 336, says:

"And where an inventor cancels from an application, a claim for a particular invention, and substitutes

no other claims for the same invention, before the patent is issued, he will be held to abandon the particular invention." (Citing cases.)

The rule laid down by the Circuit Court in the case at bar is in direct contradiction to the decision of the Circuit Court of Appeals for the Fifth Circuit in

Dry Hand Mop Co. Inc. v. Squeez-Ezy Mop Co. Inc., 17 Fed. (2d) 465 (1927),

where the Court said, at p. 466:

"The voluntary relinquishment of the element gives the public the right to use it in substitution as against any claim of equivalency."

The Circuit Court seems to imply that the burden of proof was on the petitioner and not on the respondent to show why the three claims were cancelled, when it says:

"Certainly no such intent was proven here" (Opinion, Record p. 174, fol. 175).

The Court then says:

"We shall dispose of the case on the assumption that the reason does not appear, for the record is silent" (Opinion, Record p. 174, fol. 175).

Immediately thereafter the Court enters the realm of conjecture to determine why the patentee abandoned the claims, and says:

"Be that as it may, there is a conclusive reason in this case which would put Claim One outside the exception, even if it had been shown that the applicant had actually intended to surrender the contents of the cancelled claims. All of them contained as an element that the paste or the olives must be salted; and the defendant does not salt the olives out of which it makes its paste. The applicant may well

have cancelled the three claims in question precisely, because they did not include that 'much less preferable' alternative, which he had disclosed and claimed. We therefore hold Claim One entitled to the same range of equivalents as though the three claims had not been cancelled; and that, when the defendant lengthened the time and reduced the temperature, it adopted the equivalent of a 'short' time and a 'slightly elevated temperature'."

All this without a word about it in the record, as the Court itself concedes (Record p. 174, fol. 175).

In making this assumption the Circuit Court proves conclusively that petitioner did not infringe, as the Circuit Court states that the difference between the claims cancelled and those retained by the inventor is the mention of salted olive paste in the cancelled claims (Opinion, Record p. 174, fol. 176). But, as we have shown, the respondent is using salted olive paste, for that is the only thing specified in the patent. In fact the patentee states that unsalted olives "are not capable of treatment in accordance with this invention" (Record p. 148, lines 21 to 23, column 2). Therefore, he has cancelled the process he described, and retained a claim of a process that he does not disclose in his patent.

Lastly, if we are to read the claim upon specification, as the Circuit Court says we must, it becomes apparent that the patent in question was granted for an infusion process of specially prepared olives as described in said specification (Record p. 147), while the olives used by petitioner are ordinary olives sold in the open market, which were known to the trade long before the patent in question (Record p. 120, fol. 358); furthermore the olive paste used by the petitioner is not salted, while the one used by the respondent is salted (Record p. 174, fol. 176).

POINT II

Product claim.

The product claim is invalid on its face.

Revised Statutes, Sect. 4888, 35 U. S. C. § 33;
Holland Furniture Co. v. Perkins Glue Co., 277
U. S. 245 (1927);
General Electric Co. v. Wabash Appliance Co.,
304 U. S. 364 (1937);
United Carbon Co. v. Binney & Smith Co., 317
U. S. 228 (1942).

This Court speaking through Mr. Justice Stone said in *Hollander Furniture Co. v. Perkins Glue Co.*, *supra*, at page 257:

“Revised Stat. Sect. 4888, requires that patent shall contain a description of the invention ‘and of the manner and process of making, constructing, compounding, and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.’ One attempting to use or avoid the use of Perkins’ discovery as so claimed and described functionally could do so only after elaborate experimentation. Respondents say that laboratory tests would be insufficient and that ‘the best and probably the only satisfactory test is to try it out on a large scale in a furniture or veneering gluing factory.’ A claim so broad, if allowed, would operate to enable the inventor who has discovered that a defined type of starch answers the required purpose to exclude others from all other types of starch and so foreclose efforts to discover other and better types. The patent monopoly would thus be extended beyond the discovery and would discourage rather than promote invention.”

And again speaking through Mr. Justice Read in the case of *General Electric Co. v. Wabash Appliance, supra*, this Court said at page 368:

"We need not inquire whether Pacz exhibited invention, or whether his product was anticipated. The claim is invalid on its face. It fails to make a disclosure sufficiently definite to satisfy the requirements of R. S. § 4888, 35 U. S. C. § 33. That section requires that an applicant for a patent file a written description of his discovery or invention 'in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains * * * to make, construct, compound and use the same; * * * and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' "

And further at page 372:

"But Congress requires for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted. The difficulty of making adequate description may have some bearing on the sufficiency of the description attempted, but it cannot justify a claim describing nothing new except perhaps in functional terms. *It may be doubted whether one who discovers or invents a product he knows to be new will ever find it impossible to describe some aspect of its novelty.*" (Italics ours.)

concluding at page 373 with:

"The product claims here involved cannot be validated by reference to the specification. Assuming that in a proper case a claim may be upheld by reference to the descriptive part of the specification in order to give definite content to elements stated in the claim in broad or functional terms, the specification of the Pacz patent does not attempt in any way to describe the filament, except by mention of its coarse-grained quality. Even assuming that definite-

ness may be imparted to the product claim by that part of the specification which purportedly details only a method of making the product, the description of the Pacz process is likewise silent as to the nature of the filament product. Although in some instances a claim may validly describe a new product with some reference to the method of production, a patentee who does not distinguish his product from what is old except by reference, express or constructive, to the process by which he produced it, cannot secure a monopoly on the product by whatever means produced. 'Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent, which is not made by that process.'

"Finally, the product claims may not be saved by a limitation to products produced in accordance with the process set out in the specification. This construction, though possibly of no avail against respondent, might add to the protection afforded petitioner by the process claims, if they are valid, in view of its application to filaments produced abroad. But putting aside questions as to the general propriety of such a construction, unless the claim uses language explicitly referring to the method of preparation, or describing the product in phrases suggestive of that process, to save the product claim in this fashion would constitute an improper importation into the claim of a factor nowhere described there. The claims in suit seek to monopolize the product however created, and may not be reworded, in an effort to establish their validity, to cover only the products of the process described in the specification, or its equivalent."

See also the language of this Court speaking through Mr. Justice Jackson, appearing on pages 11 and 12 of this brief.

The Circuit Court of Appeals for the Fifth Circuit considering a patent affecting dyeing fruit in the case of *Fruit Treating Corporation, et al. v. Food Machinery*

Corp., 112 Fed. (2d) 119 (1940), cert. denied 311 U. S. 679, said at page 121:

"When a patent is claimed for discovery, the law requires the patentee to state its component parts with clearness and precision, and to give a practical statement of its ingredients. When this burden is not met, or is met only vaguely and ambiguously, and it is apparent on the face of the specifications that no one could use the invention without first ascertaining by experiment the exact proportions of the different ingredients required to produce the result desired, it is the duty of the Court to declare the patent void. In this case, the temperature variations, the shade or concentration of color desired, and the wide choice of ingredients, with their different powers and qualities, require a formula changing according to conditions. It is hardly conceivable that anyone, however skilled in the art, could obtain satisfactory results when dyeing oranges by the process patented without repeated experiments. Moreover, if from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. *Wood v. Underhill*, 5 How. 1, 12 L. Ed. 23.

"The patentee, obviously in an effort to make his claims and specifications so all-inclusive that any process for the dyeing of oranges that might be devised would necessarily infringe his patent, not only has made them too broad to be included in the scope of the monopoly given by the patent laws, but he has failed sufficiently to particularize a definite formula or process, complete with ingredients and the proportions of their mixture, which is essential to a valid patent. Since each of the three claims in question depend for its validity upon the sufficiency of the disclosures of the patent, the defect mentioned is the spoliation of all, and the bill of complaint should have been dismissed."

The decision of the Circuit Court in the case at bar is contrary to its own decision in the case of *B. B. Chemical*

Co. v. Cataract Chemical Co., 122 Fed. (2d) 526 (1941), where the Court said at page 529:

"But it was not enough to avoid dedicating his invention to the public to teach those skilled in the art how to practice it; he was required to state clearly what he claimed to be new in his invention. *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 58 S. Ct. 899. 82 L. Ed. 1402. To secure a good patent, he had to secure valid claims for they are the measure of the grant to a patentee. *Smith v. Snow*, 294 U. S. 1, 55 S. Ct. 279, 79 L. Ed. 721. All the claims in suit were held valid below because it was found that they did sufficiently define what he claimed.

"We are, however, unable to agree. The viscosity of the softener of claims 1, 20 and 21 is whatever will cause it to remain, when not under pressure, substantially where placed on dried pyroxylin cement and that of claim 2 is merely 'high'. Despite the fact that viscosity could be measured and stated accurately in terms of known definite symbols, Wedger described it merely in terms of what the desired viscosity would cause the softener to do. That is insufficient since it would create an unlawful extension of coverage by permitting a patentee to adopt the expedient of describing his product in the terms of function. *Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, 48 S. Ct. 474, 72 L. Ed. 868. As was said in *General Electric Co. v. Wabash Appliance Corp.*, *supra* (304 U. S. 364, 58 S. Ct. 903, 82 L. Ed. 1402), 'The difficulty of making adequate description may have some bearing on the sufficiency of the description attempted, but it cannot justify a claim describing nothing new except perhaps in functional terms.' And unless the word 'high' has an accepted meaning in the art or is defined in the specifications, claim 2 is left too vague to be valid. Moreover, claims 1, 19, 20 and 21 also are tied to the term 'high viscosity nitrocellulose' or 'high viscosity cellulose derivative.' The Trial Court found on somewhat disputed, but clearly sufficient, evidence that the art knew no definite meaning for the expression 'high

viscosity' as applied to nitrocellulose. We must, therefore, turn to the specifications to find whether Wedger there defined these expressions used in his claims.

"The importance of this flows from the statutory requirement of R. S. Sec. 4888, 35 U. S. C. A. Sec. 33, that a patent application must not only so describe the invention or discovery that one skilled in the art may learn how to practice it but 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' And this has been emphasized within the last few years in *General Electric Co. v. Wabash Appliance Corp.*, *supra*, as follows: 'Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. * * * The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' "

A claim for a product must define a substance which is different from previously existing substances.

The product claim to be new must be defined, not by the way the product is made, but by certain characteristics which will distinguish it from pre-existing similar products, for example, by color test, precipitation test or any other reaction, whether physical, chemical or mathematical.

The product claim in the patent in issue does not define the quantity or proportion of olive oil infused into the corn oil as one to the other.

"A small amount" is not a definite ratio and therefore the resulting product as described in the claim will make

any mixture, whether infused or otherwise, of corn oil and olive oil to be an infringement.

The term, "low moisture containing," is again an indefinite statement giving no information of how much or in what ratio is the moisture reduced from its original contents. All oils manufactured previously to issue of this patent, particularly corn oil containing olive oil, were free of fibers of olive fruit.

"Having a novel flavor" does not define with what other flavor it is comparable or in what way it differs from corn oil containing olive oil that was in existence previous to the issue of this patent.

It is axiomatic that the description of the invention cannot be used to enlarge the scope of a claim. The claim is the statement of the invention and of its scope—not the description.

But let us assume that the claim is good. It still does not anticipate the product of the petitioner, for the petitioner uses unsalted olives (Record p. 174, fol. 176).

The patentee states that unsalted olives are incapable of treatment in accordance with his invention:

"The high moisture containing olive in its original and natural condition is not capable of treatment in accordance with this invention. Where the original undried olive is ground to a paste and where that paste is then added to and mixed in the glyceride oil, said glyceride oil does not take on the desirable flavor and aromatic and other characteristics which are obtained when the olive is first processed in the manner indicated above and then ground in the glyceride oil" (Record, p. 148, lines 21 to 30, column 2).

In view of the above, we respectfully submit that the product claim is invalid, but if valid it certainly is not infringed.

Conclusion

The questions above adjudicated by the Circuit Court of Appeals are of great importance to the administration of the patent laws and of great public interest. The petition for a writ of certiorari should be granted.

Respectfully submitted,

JOSEPH JOFFE,
Counsel.

New York, October, 1945.

(9)

U.S. - Supreme Court,
FILED
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CHARLES ELMORE CRO
O.L.

In the Supreme Court of the United States

October Term, 1945

No. 500

ALBA TRADING CO., INC.,

Petitioner,
(Defendant below),

—against—

MUSHER FOUNDATION, INC.,

Respondent,
(Plaintiff below).

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

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In the Supreme Court of the United States

OCTOBER TERM, 1945

No. 500

ALBA TRADING CO., INC.,

Petitioner,
(Defendant below).

—against—

MUSHER FOUNDATION, INC.,

Respondent,
(Plaintiff below).

Respondent's Brief in Opposition to Petition for a Writ of Certiorari.

Statement of the Case.

The patent in suit, No. 2,221,404 was applied for by Sidney Musher of New York, N. Y., and issued on November 12, 1940, to Musher Foundation, Inc., New York, N. Y., and this patent was sustained as to its two claims, a process claim and a product claim, by unanimous opinion of the Circuit Court of Appeals for the Second Circuit (Hon. Learned Hand) on July 18, 1945.

The Circuit Court of Appeals reversed the U. S. District Court for the Southern District of New York (Hon. John W. Clancy).

The petitioner has not put in evidence any prior art to rebut the presumption of validity of the patent.

The patent discloses an imitation olive oil made from corn oil by placing in such corn oil a paste of crushed dehydrated olives and after these crushed dehydrated olives are permitted to stay in the corn oil for a period of time, they are removed and the resultant corn oil not only takes on an unusual and unexpected strong olive aroma and flavor from the crushed olives which enable it to sell as an imitation olive oil, but it furthermore is highly stabilized against deterioration and rancidity which is an altogether unexpected result (R. pp. 30, 31, 51, 84).

While the treatment of the corn oil with crushed dehydrated olives may be carried out at room temperature according to the patent (p. 2, col. 2, line 19), in the preferred process as set forth in claim 1 on page 2 column 1, lines 53 to 59, the time of treatment of the corn oil with the ground olives may be shortened by using an elevated temperature for a shorter period of time (see patent R. p. 148).

The process set forth in the patent is carried out with dehydrated olives, but it may be carried out with salted or unsalted olives. The defendant-petitioner, Alba Trading Co., Inc., deliberately or because of lack of knowledge confuses the need for dehydration with salting at pages 16 and 23 of its petition.

Other imitation olive oils were on the market prior to and after the granting of the patent. It has been and still is quite customary to blend olive oil with a less expensive oil. For example, in a customary imitation olive oil 20% of olive oil is blended with 80% of corn oil (R. p. 32).

Other imitation olive oils are made by adding synthetic flavors (R. p. 32).

According to the patent in suit, the imitation olive oil, although practically entirely corn oil, was stable against deterioration and had a highly desirable flavor and aroma characteristic of natural olive oil (R. pp. 36, 37, 51, 80, 81 and 84) which gave considerable commercial success to the

patented imitation olive oil and enabled it to be sold through three licensees of plaintiff-respondent quite readily and widely in competition with other imitation olive oils during the period of 1940 to 1944.

The infringer, Alba Trading Co., Inc., the petitioner here, disregarding the possibility of securing a license, came into the market exactly copying the patented process and product, utilizing the procedure of treating the corn oil with dehydrated olive paste but merely making a trivial change in the preferred procedures set forth in the specification in lengthening the time of treatment by using a lower treating temperature.

The present petition does not fall within any of the categories covered by any rules of the United States Supreme Court since:

1. There is no conflict between decisions of different Circuit Courts of Appeals as to the patent.

2. There is no constitutional question involved.

3. There is no question as to difference between State and Federal law.

4. There is no great public interest in a monopoly in one form of imitation olive oil since respondent has given three licenses and is willing to license infringing petitioner and any others upon reasonable terms.

5. The public is not being deprived of imitation olive oil since other imitation olive oils not within the scope of the patent are now and have always been upon the market.

The patent contains only two claims, Claim 1 of which relates to the process and Claim 2 to the product. As sole reason for finding Claim 1 not infringed below, the District Court (Judge Clancy) assigned the omission of the defendant-petitioner to carry out the infusion of the macer-

ated olive paste at "a slightly elevated temperature" as stated in the claim. Judge Clancy held Claim 2 invalid for indefiniteness.

Therefore the only questions presented to the Circuit Court of Appeals for the Second Circuit and which the defendant-petitioner now seeks to have certified were

1. Does the defendant avoid infringement of claim 1 by carrying out the process described in the patent at room temperature for a longer period of time instead of "at a slightly elevated temperature" for a shorter period?
2. Is claim 2 so indefinite that it is impossible of construction as to what would constitute infringement?

The Circuit Court of Appeals for the Second Circuit in an unanimous opinion (Judge L. Hand) answered those questions in accordance with well settled rules of law and claim interpretation and reversed the District Court on both claims.

Since the defendant-petitioner was unable to discover any prior anticipatory art, its present request for a review of the judgment of the Circuit Court of Appeals for the Second Circuit is the equivalent of asking this Court to hold a patent invalid on its face without any substantial defences being offered.

Argument.

There is little question that the patent in suit, No. 2,221,404, granted November 12, 1940, was infringed and the novelty of the patented subject matter is apparent since the infringer, Alba Trading Co., Inc., was unable to find any prior art or pertinent literature or patents which would in any way invalidate or even approach the patented procedure.

The infringer in defending this suit merely relied upon tenuous and technical defences involving

(a) minor variations from the preferred procedure set forth in process claim 1 of the patent, although utilizing a fully equivalent process and

(a) the contention that claim 2 which was exactly duplicated in its commercial procedures was indefinite. As Judge Learned Hand stated (R. p. 170) :

"The defendant did not put in any evidence of the prior art, but relied upon two points; that it did not infringe Claim One and that Claim Two was invalid for indefiniteness."

The Circuit Court of Appeals for the Second Circuit speaking through Judge Hand described the process of the patent as follows:

"The disclosure is for a process of making an imitation olive oil by infusing a 'glyceride' oil—such as cottonseed, or corn oil—with a 'macerated' paste made from dried olives; the first claim is for the process; the second for the product. * * * This infusion is carried on 'preferably while the oil is at a slightly elevated temperature or such as is about 160° F. to 200° F. and desirably at about 175° F.' Thereafter the mixture is 'agitated' for 'from one minute to several hours;' and it is then filtered to take out 'undesired solids'."

The Court of Appeals pointed out that the only differences were, namely,

"two differences, and only two appear: the process is carried on at room temperature and not for a 'short time'."

It was pointed out by Judge Hand (R. p. 172) that

"The specifications speak of heating as in any case only 'preferred' during the infusion. Moreover,

when dried salted olives are added directly to the oil, and put through a colloid mill, no heat is necessary; and the period of subsequent 'agitation' can be entirely dispensed with, when the paste, after being thoroughly dispersed under heat, is put through such a mill. The undisputed testimony was that temperature and time are correlative factors in the infusion, as is generally the case in all chemical processes: i.e. the time may be shortened, if the temperature is raised, and must be lengthened, if it is not. Claim One selects, as the combination, 'a slightly elevated temperature' and 'a short time'; the defendant departs from this by using no heat but allowing the infusion to go on for three days at least."

It is clear that even with an extremely narrow range of equivalents this case would come directly under *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41.

The Court of Appeals stated (R. p. 173) :

"There was absolutely no prior art; for the passing references in the testimony to earlier processes, on which the defendant relies, were totally inadequate under well settled law; moreover, the invention has had a very considerable success. Of course, the fact that verbally the infringing process is not within the claim is no objection to the application of the doctrine of equivalents; indeed it creates the very occasion which should evoke it. *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41; *Claude Neon Lights v. Machlett & Son*, 36 Fed. (2) 574, 575 (C. C. A. 2); *Black & Decker Manufacturing Co. v. Baltimore Truck Tire Service Corporation*, 40 Fed. (2) 910, 914 (C. C. A. 4)."

The infringer, the petitioner herein, however, attempts to claim that the cancellation of three allowed claims (directed to using salted olives) for the purpose of transferring the subject matter to another application and to set up a clear line of division prevents the alleged in-

fringed process from coming within the process claim 1 of the patent in suit.

However, it is well known that in Patent Office procedure claims shifted from case to case; claims are cancelled to reduce the total number of claims, and claims are often cancelled or shifted to maintain clear lines of division between copending applications as was done in this case and in all these cases it is obvious that there is no estoppel or disclaimer actual or implied in cancelling claims.

Estoppels and disclaimers are only involved where claims are cancelled to avoid rejection upon prior art, prior patents, or prior publications and the Supreme Court cases cited in the brief in support of the Petition for Writ of Certiorari are all specifically directed to such instances. This is true of *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228 (1942); *General Electric Co. v. Wabash Corp.*, 304 U. S. 364 (1937); *Schreiber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 220 (1940), and *Leggett v. Avery*, 101 U. S. 256, 259 (1879).

There is no comparison between the situation in the present case and that where an actual disclaimer (not cancellation of claims) was filed in *Altoona Public Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477 (1935).

Judge L. Hand well disposed of this contention referring to *Smith v. Snow*, 294 U. S. 1, 14, 15; *Schreiber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 220; *Exhibit Supply Co. v. Ace Patent Co.*, 315 U. S. 126, 136. Judge Hand stated:

“When an applicant cancels a claim which has already been allowed, none of this reasoning applies, and at best it becomes an open question which must be proved, whether he intends to surrender the disclosure in such sense that he abandons any equivalents of the elements of those claims which he keeps. Certainly no such intent was proved here.”

In any case, the claims which were cancelled were more limited than the claims at present in suit since they were directed to salted olives as contrasted to unsalted olives which the infringer here claims were used. The Circuit Court of Appeals stated in this regard:

"All of them contained as an element that the paste or the olives must be salted; and the defendant does not salt the olives out of which it makes its paste. The applicant may well have cancelled the three claims in question precisely, because they did not include that 'much less preferable' alternative, which he had disclosed and claimed. We therefore hold Claim One entitled to the same range of equivalents as though the three claims had not been cancelled; and that, when the defendant lengthened the time and reduced the temperature, it adopted the equivalent of a 'short' time and a 'slightly elevated temperature'. *B. B. Chemical Co. v. Ellis*, 117 Fed. (2) 829, 833 (C. C. A. 1) was very close on the facts."

In any case, it has long been the rule that patents should be liberally construed so as to secure to an inventor the real invention which he intends to secure by his patent; furthermore, the specification may be referred to in order to explain any ambiguity in the claims, *Seymour v. Osborn*, 11 Wall (78 U. S.), 516, 547; *Railroad Co. v. Mellon*, 104 U. S. 112; *Westinghouse v. Boyden*, 170 U. S. 537.

It has also been held that temperature variations between defendant's process and that of the patent in suit do not avoid infringement if the same result is produced. *Tilghman v. Proctor*, 102 U. S. 707.

In respect to product claim 2 of the patent in suit, the defendant petitioner admitting that it comes squarely within the scope of the claim, attacks this claim upon the ground of indefiniteness although the defendant had no difficulty in exactly duplicating the subject matter thereof.

This claim describes the oil as being stabilized against rancidity or oxidative deterioration, as having novel flavor and odor characteristics derived from a paste of olives, and as being free of the fibers of olive ail.

Judge Hand in holding this claim 2 valid, stated (R. p. 175):

"Whatever may have been the recent tendency of the Supreme Court to bear more heavily than in the past upon indefiniteness of diction in claims, there can be no doubt, at least in the case at bar, that all the terms used in Claim Two are anchored in the specifications, and do not speak in terms of function—the only reason given for rejecting reference to the specifications in the last decision upon the subject. *United Carbon Co. v. Binney*, 317 U. S. 228, 234, 245 ('the description in the specification is itself almost entirely in terms of function' p. 236). To proceed to the details the specifications define 'substantially stabilized' in the following passage: 'materially improved in keeping quality, and it is frequently possible to extend the life of a glyceride oil by three or four times' (p. 2, col. 2, lines 12-14). ('substantially' is not of itself fatal to a claim; *Eibel Process Co. v. Minnesota & Ontario Paper Company*, 261 U. S. 45, 65: indeed, it must always be implied in every claim, even when not introduced, and adds nothing when it is. Were this not true, few patents could give any protection, for some departures from the precise disclosure are nearly always possible without losing the benefit of the invention.) The specifications several times describe the words 'novel flavor and odor' (p. 1, col. 1, lines 3 and 4; lines 26-34; p. 2, col. 2, lines 8-10; lines 26-28; lines 32, 33); indeed, they scarcely need any description, being themselves self-explanatory. Again, the specifications define the word 'small' by limits in specified percentage (p. 2, col. 1, lines 49-52; col. 2, lines 3, 4). Finally, 'substantially free of the fibres' means 'filtered' or 'centrifuged' (p. 2, col. 1, lines 60, 61; lines 74, 75). It is impossible to sup-

pose that anyone who really wished to respect the patent would have any difficulty in identifying what the claim covered. * * * The claim describes a glyceride oil into which there has been infused those constituents, which will dissolve out of a specified proportion of a dry, macerated olive paste, all of which is to be found in the specifications. There is no ground whatever for supposing that *General Electric Company v. Wabash Appliance Corporation, supra*, 304 U. S. 364, meant to hold that the claim for a product may not be the claim for the product of the process described in the specifications. On the contrary that possibility appears to have been recognized: 'Even assuming that definiteness may be imparted to the product claimed by that part of the specification which purportedly details only a method of making a product, the description of the Pacz process is likewise silent as to the nature of the filament product' (p. 373). It was likewise implied in *Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, 255, which was cited in the passage just quoted."

It is apparent that the Supreme Court cases urged by the petitioner do not support petitioner's position, namely,

Holland Furniture Co. v. Perkins Glue Co.,
277 U. S. 245 (1927);
General Electric Co. v. Wabash Appliance Co., 304 U. S. 364 (1937);
United Carbon Co. v. Binney & Smith Co.,
317 U. S. 228 (1942).

In *Minerals Separation Ltd. v. Hyde*, 242 U. S. 261, 270-1, the Supreme Court of the United States stated:

"The certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter."

In *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, this Court sanctioned a limited use of terms of effect or result. It stated:

"A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent."

Conclusions.

In view of the fact that:

there is no conflict between decisions of Courts of Appeals of different circuits;

there is no statute of the United States in question;

there is no great public interest in this subject matter involved in this suit (the petition does not even suggest in what manner the subject matter is alleged to be of great public interest or where it has any importance in the administration of the patent laws); and

the Circuit Court of Appeals for the Second Circuit has very ably answered the questions presented to it in accordance with old and established rules of law, this petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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New York, October, 1945.